IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	09/804,612	Confirmation No.: 3154
Applicant	:	M. Ibrahim Sezan et al.	
Filed	:	March 12, 2001	
TC/A.U.	:	2179	
Examiner	:	Truc C. Chuong	
Docket No.	:	7146.0115	
Customer No:		55648	
Title	:	AUDIOVISUAL INFORMATION MANAGEMENT SYSTEM	

Mail Stop Appeal
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

REQUEST FOR REHEARING

Sir:

In response to the Decision on Appeal of July 16, 2010, the Applicant requests that the Board rehear the Applicant's appeal, for the reasons given below.

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STATUS OF CLAIMS

    A.   TOTAL NUMBER OF CLAIMS IN THE APPLICATION

        There are 23 claims currently pending in the application.

    B.   STATUS OF ALL CLAIMS

            Claims canceled: 1

            Claims withdrawn: None

            Claims pending: 2-24

            Claims allowed: None

            Claims objected to: None

            Claims rejected: 2-24

    C.   CLAIMS ON APPEAL

        Claims 2-24 are on appeal.

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GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection presented for review are (1) whether claims 2-23 are unpatentable under 35 U.S.C. §103(a) over Oosterhout et al., U.S. Pat. No. 6,405,371 (hereinafter Oosterhout), in view of Yoshida et al., U.S. Pat. No. 6,137,486 (hereinafter Yoshida); and (2) whether claim 24is unpatentable under 35 U.S.C. §103(a) over the aforementioned combination of Oosterhout and Yoshida, and in further view of Brown et al., U.S. Patent No. 6,286,141 (hereinafter Brown).

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ARGUMENT

In a decision dated July 16, 2010, the Board of Patent Appeals and Interferences (Board) affirmed the Examiner's rejection of claims 2-23 in this patent application. The Applicant respectfully requests reconsideration for several reasons. First, the decision on appeal failed to respond to several of the Applicant's arguments of record, and in doing so failed to articulate a cogent explanation of obviousness that is required to support a rejection under 35 U.S.C. § 103(a). Instead, the Board's decision made the same error as did the primary Examiner in the final rejection being reviewed, by simply dissecting the Applicant's claims into separate limitations and then asserting that each limitation is found in at least one of the individually-cited references. *See* Decision on Appeal at p. 6 ("We find that the claimed user preference data *reads on* at least Yoshida's parental control features."); *See Id.* at p. 7 ("Here, the claimed 'electronically stored user description scheme' *reads on* Oosterhout's subprogram that allows the user to input the type of television program he is currently interested in. In addition, the claimed 'selecting without user input . . . based upon an interaction of said user description with at least one of said program description scheme' *reads on* Oosterhout's sub-program searching in the EPG data for a program meeting the inputted theme.").

A cursory review of the Board's decision shows a notable lack of any kind of obviousness inquiry, as the entire "Analysis" section is merely devoted to reading claim limitations on the separately-cited references.[1] The Board provides no explanation as to how one of ordinary skill in the art, given the teachings of the secondary references,

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[1] The extent of the obviousness analysis in the Decision on Appeal is a paragraph of boilerplate obviousness law, i.e. "If the claim extends to what is obvious, it is invalid under § 103 . . . The combination of familiar elements according to known methods is likely to be obvious when it doers no more than yield predictable results." *See* Decision on Appeal at p. 7 (citations omitted). The Decision on Appeal fails to indicate what results are achieved by the combination of Oosterhout and Yoshida and why these unmentioned results would be predictable. Instead, after reciting this boilerplate paragraph, the Decision on Appeal provides an analysis appropriate for an anticipation rejection, indicating only why selective claim terms are broad enough to read on the disclosure of Oosterhout. This is representative of the whole of the Board's analysis, which treats Oosterhout and Yoshida separately, making no effort to undergo the Graham factor inquiries of outlining the differences between the claims and the prior art, and then explaining why the differences are obvious.

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would in practice modify the system of the primary reference, and then provide an explanation of how that modified system would read on the Applicant's claims. Finally, the decision on appeal failed to give any meaning to a claim limitation that the Applicant argued as distinguishing over the prior art, in contradiction of settled law on claim interpretation.

Independent claim 21, from which all other claims depend, includes the limitation of a user description scheme that contains "electronically stored user preference data" for "a predetermined user" and indicative of "expected content preferences" for the "identified said predetermined user." Claim 21 further specifies that "an electronic device select[s] *without user input* at least one of a video, an image, and audio based upon an interaction of said user description scheme with at least one of [a] program description scheme or [a] system description scheme." Stated generally, claim 21 is directed to the electronic storage of a preference profile, indicative of persistent, expected preferences of an identified user, where that stored profile is used to automatically select programming that conforms to the profile.

The primary reference, Oosterhout, discloses a television transmitter/receiver combination capable of displaying a programming guide. In particular, the disclosed programming guide can be filtered according to instantaneous commands of a user, e.g. when a user manually inputs a "movie" category, all the movies displayed on the programming guide are highlighted or otherwise emphasized. The secondary reference, Yoshida, teaches a parental lock feature by which channels can be blocked based on the content showing on the channel, e.g. if an R-rated movie is showing on channel 25, the television receiver will not display the television signal when tuned to that channel if the parental filter blocks R-rated content. The filter data is protected by a password to prevent unauthorized persons such as minors from circumventing the parental lock by simply changing the filter parameters. This description of the prior art conforms to the Board's findings of fact. *See* Decision on Appeal at pp. 3-4.

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At the outset, the Board's decision erroneously stated that the Applicant's arguments misconstrued the final rejection under 35 U.S.C. § 103(a) as reading the claimed "user preference data . . . indicative of expected content preferences" upon Oosterhout's programming guide filter, but that "it appears that the Examiner is actually relying upon Yoshida, not Oosterhout, to disclose this feature." *See* Decision on Appeal at p. 5. This statement is erroneous both in its characterization of the Examiner's rejection and the Applicant's response. In actuality, the Examiner's final rejection never explicitly stated, one way or the other, whether the claimed "user preference data . . . indicative of expected content preferences" was read upon Oosterhout's programming guide filter preferences, as somehow modified by the teaching s of Yoshida in an undisclosed manner, or upon the parental lock menu of Yoshida as bodily incorporated into set-top box of Oosterhout. Moreover, the Applicant directly addressed this issue by arguing that the limitation could not be read upon either Yoshida alone, or *in combination* with Oosterhout. The Board's decision failed to address any of these issues.

First, claim 21 *defines* the user preference data as being "indicative of expected content preferences." It is therefore axiomatic that data not "indicative of expected content preferences" cannot be read as "user preference data" as claimed. Yet, the Examiner's Answer states that:

> As to claim 21, Oosterhout teaches . . . an <u>electronically stored</u> (Oosterhout clearly teaches the <u>microprocessor</u> 25 receives the EPG (Electronic Programming Guide) data from the transmitter and stores this information/description scheme in a <u>memory</u>, e.g. col. 3 lines 20-27) *user description scheme containing user preference data* for a user (if the "theme" button is selected, the program allows the user to input the type of television program he is currently interested in. . . ."

See Examiner's Answer at p. 3 (underlines in original, italics added); Clearly, the Examiner alleges that Oosterhout discloses "user preference data" and also discloses the later limitation of selecting programming content based on an interaction of

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Oosterhout's preference data (i.e. EPG filter instructions) with a system description scheme or a program description scheme. *See* Id. at p. 4.

As argued by the Applicant, however, what the Examiner contends is "user preference data" in the primary reference is not the "user preference data" as the Applicant has defined that term. *See* Appeal Brief at p. 9; Reply Brief at pp. 4-5. Though the Applicant *noted the Examiner's reliance on Yoshida* for disclosing a parental lock feature that "inherently teaches that after a user enters his/her password(s) he/she can view the user preference data indicative of the expected content preferences for the identified of the predetermined user because the display will view a list of movies or particular channels which were preset/predetermined by the user", the Applicant characterized this response as an improper "bait and switch" because the what the Examiner contends is preference data as taught by Oosterhout is completely different than the preference data as allegedly taught by Yoshida. *See* Appeal Brief at p. 9.

This presents two alternative scenarios, in which neither forms the basis for a proper obviousness rejection. Logically, the problem is as follows: Claim 21 defines element "A" as having characteristic "B", and using element "A" to do "C"; where "A" is user preference data, "B" is being "indicative of expected content preferences" and "C" is selecting content "without user input" and "based upon an interaction of said user description scheme with at least one of said program description scheme or said system description scheme." The primary reference discloses doing C based on "Z." (Because "Z," i.e. Oosterhout's filter, lacks characteristic B, it is not "A.") The secondary reference discloses "A", which has characteristic "B", but "A" in the secondary reference is neither "Z" of the primary reference, nor reasonably related to it. While it cannot be categorically stated that this situation will not support a contention that one of ordinary skill in the art would find it obvious to use element "A" to do "C", any obviousness rejection needs an explanation as to why that combination would be obvious, and neither the Examiner nor the Board has provided that explanation, instead being simply content to note that all claim terms could plausibly be read on one prior art reference or another, despite any

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inconsistencies and without any explanation as to how the combination of references would operate.

The Applicant's arguments of record addressed *both* hypotheses[2] that (1) the Examiner's rejection was somehow premised on using the teachings of Yoshida to modify the filter data of Oosterhout to be "indicative of expected content preferences" and alternatively (2) that the Examiner's rejection was somehow premised on the bodily incorporation of Yoshida's parental lock feature into Oosterhout such that the parental lock interface was then the "user description scheme" used to select content "without user input" and "based upon an interaction of said user description scheme with at least one of said program description scheme or said system description scheme."

With respect to the first hypothesis, the Applicant noted that the parental lock feature of Yoshida was unrelated to the filter of Oosterhout, and specifically argued that "assuming Oosterhout and Yoshida were combined, if a minor selected the theme of 'movies' and one of the subsequently highlighted sub-images was for a channel locked out by a password, then the subsequent selection of that channel by the minor would simply tune the receiver to the channel, which would display either a blank screen, a substitute "not authorized" screen, or the like. *See* Appeal Brief at p. 7. This is the way parental lock features actually work, given that the feature is not intended to restrict available content to those who know the password. Thus, the inclusion of a parental lock feature in the set-top box of Oosterhout would not (and does not) affect an EPG

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[2] There is actually a third hypotheses, perhaps the most plausible, that the Examiner has simply misread step (c) of claim 21 as only requiring the selection of content based on a *program* description scheme, and not the *interaction of* a user description scheme with either a program description scheme or a system description scheme. *See* Examiner's Answer at pp. 4, 10. The Examiner's rejection clearly reads the claimed step of identifying content "without user input" on the *automatic* ongoing search of upcoming programs prior to a user even activating the programming guide grid of Oosterhout, let alone applying a filter (*See* Examiner's Answer at p. 4). The Examiner states that this is sufficient because it is based upon "at least one of said program description scheme, said user description scheme, and said system description scheme", as if these three schemes were simply alternative elements in a Markush grouping. Claim 21 requires more than this. The Decision on Appeal, however, is premised on the assumption that the step of "without user input" reads on the application of a manually-entered filter to a database of upcoming programming. *See* Decision on Appeal at p. 7. Thus, this third hypothesis has marginal relevance to the request for rehearing as it certainly did not form the basis for affirming the Examiner's rejection.

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grid as the filters for visually showing upcoming programming always show every program that meets the criteria of the filter, even if a program would be blocked by a parental lock, absent entry of a password, else those who know the password would not be notified of the existence of an program that they want to watch, and could watch upon entry of a proper password. Therefore, the Applicant's arguments of record is that one of ordinary skill in the art would not modify the EPG filter system of Oosterhout such that the applied filters are based on a parental lock system so as to not highlight content blocked by a parental lock. Thus, under this scenario the combination of Oosterhout and Yoshida would fail to disclose both the limitations of a user description scheme defined as representing "expected content preferences" for an identified user and selecting content based on an interaction involving that user description scheme.

With respect to the second scenario, which seems to be the basis for the Board's affirming the Examiner's final rejection, the limitation of "user preference data indicative of expected content preferences" cannot be plausibly read upon Yoshida's parental lock feature as such for two reasons. First, although the Board notes that claim limitations are to be given their broadest reasonable meaning in light of the specification, the Applicant's specification discusses the claimed "expected content preferences" in a way that precludes that reading:

> The user description scheme preferably includes the user's personal preferences, and information regarding the user's viewing history such as for example browsing history, filtering history, searching history, and device setting history. The user's personal preferences includes information regarding particular programs that *the user prefers to view* . . . . The explicit definition of the particular programs or attributes related thereto permits *the system to select* those programs from the information contained within the available program description schemes 18 that may be of interest to the user. Frequently, the user does not desire to learn to program the device nor desire to explicitly program the device. . . User description scheme information is *persistent* but can be updated by the user . . . In a sense, the user description scheme is *persistent and timeless based*.

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See Specification at p. 10-11. (emphasis added); *See also Id.* at pp.18-19 (indicating that the user description scheme, via its persistent expected preferences of a user, is used to select programming for the user while the user is at work). There is no support in the specification for reading of the Applicant's claimed "user description scheme" and its "user preference data indicative of expected content preferences" on a parental lock feature that *blocks* content absent manual entry of a password so as to prevent *others* from watching predefined content. *See* Appeal Brief at pp 9-10 (arguing that Yoshida's parental lock feature cannot be considered "expected content preferences" for an "identified user" because "Yoshida teaches that, after a password is [set], someone else is prohibited from tuning to channels not authorized without the password."); *see also* Reply Brief at pp. 5-6 ("Yoshida discloses nothing of the sort, and the only inherent feature of a password is to limit access to undesirable content itself, and not "user preference data indicative of expected content preferences . . . .").

When citing Yoshida, the Examiner does allege that the parental lock feature is a user description scheme having expected content preferences, but as the Board seemingly concedes, the parental lock feature as disclosed by Yoshida does not select programming without manual input by the user due to an interaction of the parental lock data and either a program description scheme or a system description scheme. *See* Decision on Appeal at pp. 6-7 (reading this claim limitation on the disclosure of "Oosterhout's sub-program searching in the EPG data for a program meeting the inputted theme filter and, not as blocking programming pursuant to a parental lock filter."). Thus, for this latter limitation to be deemed obvious, there needs to be some explanation of how the teachings of Yoshida's parental lock modify the theme filters of Oosterhout because only the latter is alleged in the rejection to be used to select content based on an interaction with a program description scheme and "without user input." *See* Appeal Brief at p. 10.

This explanation is not provided, and in fact seems to be antithetical to any argument that the expected user preferences are *merely* the parental lock data of

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Yoshida, given that this parental lock data is not used to, and is not alleged to be used to, automatically select programming without manual input. (Programs passed through or blocked by the parental lock system are passed through or blocked only when a user tries to manually tune to the program.)

The Decision on Appeal does, at least obliquely, respond to the Applicant's other argument that the claim term "expected content preferences" does not read on the parental lock feature of Yoshida, by adopting for the first time on appeal a definition of "expected content preferences" that was neither cited by the Examiner, nor supported by the specification. Specifically, the Board appears to misinterpret the claim limitation of "expected content preferences" such that the term "content" alone is the object of the adjective "expected" so that "expected content" is merely that programming which a user may reasonably expect to be made available to it, and the preferences must only relate to that expected content in some way. *See* Decision on Appeal at pp. 5-6. This is neither grammatically correct nor consistent with the specification, which supports "content preferences" as a single object, i.e. preferences for content. Thus, the term "expected" in the quoted limitation modifies the term "preferences" or "content preferences" as a unitary object, and does not refer to preferences for "expected content", at least as the Board reads the term. Though the USPTO is to adopt the broadest reasonable interpretation of a claim in light of the specification, the issue here is not one of breadth, but one of identifying one of two disparate meanings of a claim limitation. Rather than expanding the term "expected content preferences" to its broadest reasonable meaning in light of the specification, the Board's opinion simply parses the limitation in the way it chooses. Though offering a *pro forma* recitation that claim terms are to be interpreted as broadly as is reasonable in view of the specification, the decision on appeal fails to engage in any discussion as to how and where the specification supports its proffered interpretation.

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In fact, the specification only discusses preferences of a user as data indicative of what programs (i.e. content) a user himself or herself *wishes* to watch, and indicates that these program, or content, preferences are stored in a "persistent" profile so that an automatic program selection method can select particular content from among a wide array of content based on what the system *expects that* a user *will* prefer. *See* Specification at p. 10-11; *See also Id.* at pp.18-19 (indicating that the user description scheme, via its persistently stored - i.e., expected - preferences of a user, is used to select programming for the user while the user is at work). The term "expected content preferences" therefore clearly refers to the expectation of a user's preference as to what content is desired, rather than simply a user's preferences for filtering expected content.

This is more than a semantic distinction as the final rejection presumes that the "descriptor" to identify the "identified predetermined user" is the password to the parental lockout menu, hence the "identified predetermined user" with Yoshida's "expected content preferences" is the person or persons knowing the password. But the persons who know the password use the parental lockout feature only to *block* the content that *other*s can watch, and the data in the parental lockout menu reflects, not the expected preferences of what content the persons who know the password wish to watch (because they can simply watch any program by entering the password, the parental lock data by definition does not reflect *their* expected preferences for *desired* content), but their preferences for what *others* in the household watch.

There is no support in the specification for reading the term "expected content preferences" of a "predetermined user" so broadly as to encompass data that *exclusively* functions to limit another person's access to specified programs, as does the parental lock feature of Yoshida, because that data is not a "preference" of the identified user, even as that term is most broadly described in the specification.

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Finally, the Applicant notes that the Board has improperly construed the term "without user input" by depriving that term of any meaning, essentially reading it out of the claim. *See Warner Jenkinson Co. v. Hilton Davis Chem. Co*, 520 U.S. 17, 41 USPQ2d 1865, 1871 (1997) ("Each element contained in a patent claim is deemed material to defining the scope of the patented invention . . ."). *See also Becton Dickinson & Co. v. C.R. Baird, Inc.*, 922 F.2d 792, 798 (Fed Cir. 1990)(all limitations in a claim are material such that it is improper to define "insertable storage medium" as "any storage medium."); *Johnson & Johnson Assoc., Inc. v. R.E. Serv. Co.* 285 F.3d 1046, 1052 (Fed. Cir, 2002)(en banc)("claims are interpreted with an eye toward giving effect to all terms in the claim."). The Board argues that the manual selection of a filter to apply to a programming grid of all available upcoming content, where the filter is applied by a processor, satisfies the claimed step of "selecting without user input at least one of a video, an image, and audio based upon an interaction of said user description scheme with at least one of said program description scheme" because the processor performs a search of the available programming for data, conforming to a manually input search request, without the user's further manual input. *See* Decision on Appeal at page 7. This makes no sense. The claimed user description scheme is defined by the claim as being electronically stored data, hence it cannot plausibly interact with a program description scheme to select content, as claimed, *except* through a processor, which means that the processor or other *electronic* device by its nature *always* automatically perform the final step of implementing some manual input. The Board's interpretation of claim 21 reads the term "without manual input" as being entirely superfluous; it is untenable to suggest that the Applicant's amended claim term of "without manual input" further limited the claim by preventing a person from reaching into the circuitry of the processor and physically pushing the electrons around to select the desired programming.

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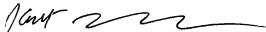Reply to Decision on Appeal mailed Jul. 16. 2010

For each of these reasons, the Applicant respectfully requests that the Board rehear the appeal in this matter and reverse the Examiner's rejection of claims 2-24.

Applicant submits that no fees are required for entry of this Request for Rehearing. If any fees are deemed necessary, however, the Commissioner is authorized to charge the requisite fee to Deposit Account No. 03-1550.

Respectfully submitted,

CHERNOFF, VILHAUER, McCLUNG & STENZEL

By

Dated: August 31, 2010

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